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OFFICE OF PETITIONS

In re Application of :
Nicholls et al. : DECISION ON PETITION
Application No. 09/315,680 :
Filed: May 20, 1999 :
Atty Docket No. 7210-000001/ :

This is a decision on the renewed petition filed on December 7, 2007, under 37 CFR 1.183 seeking waiver of 37 CFR §§ 1.67 and 1.175 where it requires that a supplemental declaration be executed by a named inventor.¹

The petition is before the Office of Patent Legal Administration for decision.

The petition is again **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. **FAILURE TO TIMELY RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.183."

¹ Once an application has received a fully executed oath or declaration and been placed on the files for examination, the provisions of 37 CFR 1.47 no longer apply. Rather, the remedy for treating an inventor's refusal to also sign a supplemental oath or declaration is waiver of 37 CFR 1.67. See MPEP 603.

REVIEW OF FACTS

1. On May 20, 1999, the application was filed as an application for reissue of U.S. Patent No. 5,631,827.
2. On August 25, 2006, an Office communication was mailed, requiring a supplemental reissue declaration. A one (1) month shortened statutory period for reply was set.
3. On October 9, 2006, a response consisting of an amendment and a petition for a one (1) month extension of time were filed. No supplemental reissue declaration was filed on October 9, 2006.
4. On February 13, 2007, a petition was filed, along with a supplemental reissue declaration naming Peter Nicholls, Robert Kinyon, Jeff Skaistis, Steve Johnson, Andy Locker, Chris Guzik, and Scott Howard, as joint inventors. The supplemental reissue declaration was signed by all inventors except joint inventors Nicholls and Johnson. Petitioners assert joint inventors Nicholls and Johnson could not be located or refused to sign the supplemental reissue declaration.
5. On May 16, 2007, the petition was dismissed because petitioners had not shown diligent efforts had been made to contact the non-signing inventor, and because the supplemental reissue declaration was defective.
6. On December 7, 2007, the present renewed petition was filed.

DECISION ON PETITION UNDER 37 CFR 1.183
TO WAIVE §§ 1.67 AND 1.175

Petitioners state that letters were sent to joint inventors Nicholls and Johnson asking them to confirm that they were former employees of the assignee's and informing them that the current assignee had documents for their review. The letters were sent to the last known addresses of each inventor using United Parcel Service (UPS). A copy of the UPS Package Tracking report was provided for the letters sent to each inventor. The UPS tracking report shows that the letter to Johnson was delivered. No response, however, was received from Johnson. The UPS tracking report for the letter sent to Nicholls indicates that no delivery was made, and that Nicholls had moved to a different address.

The renewed petition includes a declaration by Barbara Yates, counsel's paralegal, detailing the efforts made to locate the non-signing inventors.

The declaration, however, is still defective in that no residence or mailing address in accordance with 37 CFR 1.175 and 1.63 has been provided for joint inventor Nicholls. A new declaration in accordance with 37 CFR 1.175 and 1.63 signed by all of the signing inventors on behalf of themselves and the non-signing inventors must be provided.²

Suspension of the rules under 37 CFR 1.183 may be granted in an "extraordinary situation, when justice requires." The facts presented on the record do not adequately establish an extraordinary situation. In view of the failure to provide a proper oath or declaration in accordance with 37 CFR 1.175 and 1.63, petitioners have not sufficiently established any special circumstances of equities that would require suspension of the rules in the interests of justice.

This application bears an original Declaration executed by the two non-signing joint inventors, Nicholls and Johnson. Thus, the provisions of 37 CFR 1.47 do not apply in this instance. Nevertheless, it is appropriate to apply the principles for a showing under 37 CFR 1.47 to the situation at hand.

CONCLUSION

1. The petition is dismissed.
2. Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571)273-8300
Attn: Office of Petitions

² In this regard, petitioner should note MPEP 605.03 which states that, in reference to the mailing or post office address, in situations where an inventor does not execute the oath or declaration and the inventor is not deceased, such as in an application filed under 37 CFR 1.47, the inventor's most recent home address must be given to enable the Office to communicate directly with the inventor as necessary.

By hand: Customer Service Window
Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

3. Telephone inquiries related to this decision only should be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.

4. Inquiries regarding petition status or general petition information are handled by the Office of Petitions staff at (571) 272-9282.

A handwritten signature in black ink, appearing to read "Kenneth M. Schor", with a large, sweeping flourish at the end.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy